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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/363,129	07/28/1999	MARY SWAAB	500159	7758

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EXAMINER

MACKEY, JAMES P

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 02/27/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/363,129

Applicant(s)

SWAAB

Examiner

James Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 7, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 25-29, and 31-43 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6-9, 11, 12, 26-28, 31-33, 35-37, and 40-42 is/are allowed.
- 6) ☒ Claim(s) 5, 10, 34, 38, 39, and 43 is/are rejected.
- 7) ☒ Claim(s) 25 and 29 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Orefsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Petent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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1. The terminal disclaimer filed on Jan. 7, 2002, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 5,971,351, has been reviewed and is accepted. The terminal disclaimer has been recorded.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 34, 38, 39 and 43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original specification does not adequately describe that the base is "neutral" (although page 8, line 24 of the original specification does provide support for the base being "not shaded"), as is claimed in new claims 34 and 39. Moreover, the original specification does not adequately describe that "the pigments are stored separately from the pigments in a readily mixable state, such that the pigments are pourable and mixable with other pigments without heating", as is claimed in new claims 38 and 43.

4. Claim 25 is objected to because of the following informalities: In claim 25, line 3, "a plurality pigments" should be --a plurality of pigments--. Appropriate correction is required.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5, 10, 34 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, line 3, "conventional oven" is of indefinite scope, since the metes and bounds of what is considered to be "conventional" cannot be ascertained.

In claim 10, "the mold top and bottom clam shells" on lines 1-2, and "the mold top and bottom" on line 3 both lack proper antecedent basis in the claim.

In claims 34 and 39, "neutral" is indefinite as to exactly what is intended (is this neutral pH or some other neutral chemical or physical aspect of the material?).

7. Claim 29 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 29 only recites the intended use of the claimed kit apparatus, by merely reciting where and how the claimed kit is intended to be used; such relates only to the manner or method in which the kit is intended to be operated, which does not structurally distinguish the claimed kit, and therefore does not further limit the structure of the claimed kit. Note that intended use has been continuously held not to be germane to determining the patentability of the apparatus, *In re*

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Finsterwalder, 168 USPQ 530. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235.

Applicant argues, in the Response filed on Jan. 7, 2002, that claim 29 "sets forth positive limitations on how the kit is packaged". However, the Examiner disagrees. Claim 29 recites that "the kit is packaged for resale through a retail establishment whereby the kit is adapted to be used by an individual at home or other locations away from the retail establishment", which does not recite any structural limitations on the claimed kit.


8. Claims 1-4, 6-9, 11, 12, 26-28, 31-33, 35-37 and 40-42 are allowed.

Claims 5 and 10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is (703) 308-1195. The examiner can normally be reached on Monday-Friday from 8:30AM to 6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nam Nguyen, can be reached at (703) 308-3322. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651. Any inquiry relating to the contents or papers filed in this application, other than issues of substance requiring the attention of the Examiner, should be directed to the Customer Service Office, Technology Center 1700, whose telephone number is (703) 306-5665.

MACKEY/jpm
February 25, 2002


JAMES MACKEY
PRIMARY EXAMINER
ART UNIT 1722

2/25/02